

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested. Claims 2-9 are pending in the present application, with claims 2, 3, and 7 being independent. Claim 9 has been added by this amendment, which does not add any new subject matter.

Drawings

Previously, Applicant respectfully requested that the Examiner indicate in any subsequent Office Action whether or not the drawing that was filed on March 2, 2000, is accepted (see item 10 of the Office Action Summary). The Examiner, however, failed to provide any such indication in the outstanding Office Action. Thus, Applicant once again respectfully requests that the Examiner indicate whether or not the drawing that was filed on March 2, 2000, has been accepted.

Claim Rejections Under 35 USC §112

The Examiner rejected claims 2-8 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Applicant has amended the claims to correct each of the minor informalities identified by the Examiner. In addition, Applicant

respectfully submits that these amendments do not narrow the scope of the claims.

Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 USC §103

The Examiner rejected: claims 2 and 8 under 35 USC §103(a) as being unpatentable over Rothblatt (US 6,105,060) in view of Fortman et al. (US 5,987,100), Shimizu et al. (US 3,878,333) and Spracklen ("Digital Communications Protocol in the Satellite Environment"); claims 3 and 5 under 35 USC §103(a) as being unpatentable over Rothblatt in view of Shimizu et al. and Applicant's Admitted Prior Art (AAPA); claim 4 under 35 USC §103(a) as being unpatentable over Rothblatt, Shimizu and further in view of Spracklen; claim 6 under 35 USC §103(a) as being unpatentable over Rothblatt, Shimizu, AAPA, and further in view of Fortman et al.; and claim 7 under 35 USC §103(a) as being unpatentable over Rothblatt, in view of Shimizu et al., Spracklen, and AAPA. These rejections are respectfully traversed insofar as they pertain to presently pending claims.

To establish a prima facie case of obviousness, three basic criteria must be met: (1) there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be

a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations, see *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully submits that the Examiner failed to substantiate a *prima facie* case of obviousness for at least the foregoing reasons.

Independent claim 2

Independent claim 2 is directed to a system for transmitting data to computers of requesting users over a wideband satellite transmission channel. For requesting the data, the users are connected to a base station, which is connected to the Internet, via a shortwave radio path for transmitting a request for data according to a TCP/IP protocol. The requested data is then sent to a mailbox in the Internet for the users. Thereafter, the users are notified, by a notification, about the sent data via the shortwave radio path and the users download the sent data over said wideband satellite transmission channel onto their computers.

In rejecting independent claim 2, the Examiner correctly acknowledges on page 4 of the Office Action that "Rothblatt did not specifically teach to use shortwave radio path for transmitting data according to a TCP/IP protocol and for notifying about the sent data; and the requested data is sent to a mailbox in the Internet for the users."

The Examiner, however, alleges that Rothblatt teaches the feature that "users are notified about the sent data," and cites col. 4, lines 37-44, col. 5, lines 27-32, and col. 12, lines 55-66, of Rothblatt for support thereof. Applicant respectfully disagrees.

Referring to those cited sections of Rothblatt, it is merely taught that digital information that is assembled by the system gateway 23 is formatted into a broadcast channel frame having a service control header (SCH). In col. 12, lines 55-66, of Rothblatt, it is taught that the Internet Service Provider (ISP) notifies a user of a L band frequency to which the digital broadcaster 21 needs to be tuned to prior to accessing the Internet.

Applicant fails to understand the Examiner's rationalization as to how an added header (e.g., the SCH of Rothblatt) or how frequency tuning information can be reasonably construed to teach the feature recited in claim 2, e.g. that the users are notified about data that is sent to a mailbox in the Internet.

Then, the Examiner alleges that Fortman teaches the feature of storing data in a mailbox and notifying users about the data prior to the user's access to the data. The Examiner then appears to allege that the motivation to combine Rothblatt and Fortman is to enhance Rothblatt's method to store user requested data in a mailbox, which is supposedly taught in col. 5, lines 19-24 and 27-31 of Rothblatt. Referring to that cited section of Rothblatt,

Applicant notes that it is taught that data (which is requested by many users at similar times) is stored in a download buffer. However, the users in Rothblatt do not receive a notification that this data has been sent to the buffer - an SCH header is not a notification, as discussed above. Thus, there is no motivation to combine Rothblatt with Fortman et al.

Thereafter, the Examiner then correctly acknowledges that neither Rothblatt nor Fortman teach that users are connected to a base station via a shortwave radio path for transmitting a request for data according to a TCP/IP protocol. The Examiner, however, alleges that Shimizu teaches this feature and cites col. 1, lines 3-7, col. 4, lines 17-24 and 37-45, of Shimizu for support thereof.

The Examiner then alleges that the motivation to combine Rothblatt, Fortman, and Shimizu is "because Shimizu's teaching of using shortwave circuits in transmitting message [sic] enhance Rothblatt and Fortman's system to transmitting using high frequencies."

Shimizu is directed to an ARQ system for data transmission circuits using a short wave circuit. A block of characters is sent from a master station to a slave station, while an acknowledgement signal is transmitted in the opposite direction. If an error occurs during the transmission, the block of characters are automatically retransmitted. Thus, clean output without an error is obtained on a printer in a receiving or slave station.

Applicant respectfully submits that the Examiner failed to reasonably show any motivation to combine these references. Rothblatt only teaches a communication system that transmits from a user terminal 22 to a satellite 24 and then a digital broadcast satellite 20 transmits data, via a TDM downlink beam 30, to the user terminal 22. In fact, Rothblatt teaches away from the use of a shortwave radio path in col. 1, lines 25-27, which teaches that "communication services have...been characterized by the poor sound quality of shortwave radio broadcasts." Thus, one skilled in the art would not combine the teachings of Shimizu with Rothblatt.

Even further, the Examiner then utilizes Spracklen to teach the feature of transmitting a request, via a shortwave radio path, according to a TCP/IP protocol. Spracklen, however, does not teach that a TCP/IP protocol is utilized via a shortwave radio path. Thus, one skilled in the art would not look towards Spracklen for the deficiencies of the alleges combination of Rothblatt, Fortman, and Shimizu.

An essential evidentiary component of an obviousness rejection is a teaching or suggestion or motivation to combine the prior art references.¹ Combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventors' disclosure as a blueprint for piecing together the prior art to

¹ see *C.R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225 (Fed. Cir. 1998).

defeat patentability -- the essence of hindsight.² Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem solved.³ However, a rejection cannot be predicated on the mere identification of individual components of the claimed limitations.⁴ Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed.⁵

It appears that the Examiner is utilizing a lego® approach in combining the cited art. The Examiner has used nothing more than hindsight in order to combine Rothblatt, Fortman et al., Shimizu, and Spracklen and has identified nothing in either publication that could be construed as a suggestion, teaching or motivation to combine the prior art references. Thus, the Examiner's reference combination is improper.

Applicant would like to direct the Examiner's attention to MPEP 2145, which recites in part that "[r]eliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991)." In addition, MPEP 2141

² see *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985).

³ see *In re Dembiczak*, 50 SPQ2d 1614 (Fed. Cir. 1999).

⁴ see *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000).

recites in part that:

Office policy is to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

(A) Determining the scope and contents of the prior art;

(B) Ascertaining the differences between the prior art and the claims in issue;

(C) Resolving the level of ordinary skill in the pertinent art; and

(D) Evaluating evidence of secondary considerations.

Independent Claims 3 and 7

In rejecting independent claim 3 and 7, the Examiner alleges that the combination of the cited art, as noted above, renders independent claims 3 and 7 obvious. Applicant respectfully disagrees.

Applicant respectfully submits that one skilled in the art would not combine the cited art, as detailed above for similar reasons as presented above, with respect to claim 2.

In other words, as explicitly outlined hereinabove, one skilled in the art would not modify Rothblatt's system to include the shortwave radio path transmission of Shimizu, because Rothblatt does not teach the usage of any other transmission path besides a satellite path from the user to the base station and, as detailed above, teaches away from using a shortwave radio path by

⁵ Id.

specifically stating that a shortwave radio path has a poor sound (e.g. transmission) quality.

Thus, in view of the above discussion, it should now be evident that a *prima facie* case cannot be substantiated. Accordingly, withdrawal of the rejections is respectfully requested.

Dependent claims 4-6 and 8-9 should be considered allowable at least for depending from an allowable base claim.

Conclusion

In view of the above amendments and remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

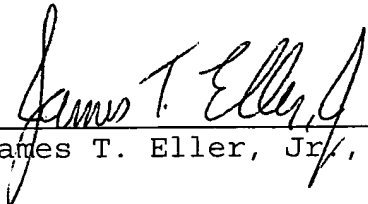
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Martin R. Geissler (Reg. No. 51,011) at the telephone number below.

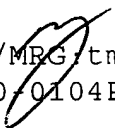
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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